REMARKS

This is in response to the Office Action dated October 28, 2004. Reconsideration is respectfully requested.

Request for Extension of Time

Applicant respectfully requests that the time period to reply to the Action be extended three months, from January 28, 2005 to April 28, 2005. Enclosed is Credit Card Form PTO-2038 authorizing the charge of $510 in payment of the three-month extension pursuant to 37 CFR 1.17(a)(3).

Summary of Rejections

Claims 1-4, 14-17, 19, 20, 24-26 and 30-33 are pending in the application and all are rejected as obvious over U.S. Patent No. 4,287,245 to Kikuchi in view of U.K. Patent Application No. GB 2096616 to Tonokawa and further in view of U.K. Patent Application No. GB 2296749 to Villain.

Arguments Traversing the Rejections

Applicant respectfully traverses the rejections of the pending claims contending that the cited references fail to meet the criteria required to establish a prima facie case of obviousness. In arguments presented below, applicant supports this position on a claim-by-claim basis.

Claim 1

Claim 1 recites a preformed insulation module, an example of which is illustrated in Figures 1 and 2. Claim 1 recites that the module comprises, among other elements, an inner insulation layer formed of flexible insulation material and a contraction/expansion joint positioned between the ends of the module, the joint comprising a recess that extends both circumferentially around a longitudinal axis of the module and radially outwardly. The recess terminates in spaced apart

relation to a cladding layer also recited in the claims. The contraction/expansion joint provides for longitudinal expansion and contraction of the insulation layers in which it is formed. An example of the inner insulation layer may be seen in Figure 2 at 314. An example of the contraction/expansion joint may be seen in Figure 1 at 370.

Applicant respectfully asserts that neither one of these claim elements is either taught or suggested in Kikuchi and, furthermore, that it is improper to combine Kikuchi with Tonokawa in support of the obviousness rejection.

With respect to the contraction/expansion joint, the Examiner maintains that such a joint comprising a recess is illustrated in Figure 4 of Kikuchi by reference character 5. Contrary to the Examiner's assertion, however, reference character 5 does not illustrate a recess, but points to a heat insulating material having good compression stability. The heat insulating material 5 is "compressively packed in the inner section [and] expands and absorbs stress caused by the shrinkage of the element 2, thus completely preventing the occurrence of cracks or breakage in the joint portions". (Column 8, lines 30-39). From this description, we determine three important differences between the joint disclosed in Kikuchi and applicant's invention as recited in Claim 1. First, the contraction/expansion joint disclosed in Kikuchi is not a recess as recited in Claim 1, but comprises an insulating material having a particular set of properties. Second, the contraction/expansion joint disclosed in Kikuchi compensates for shrinkage of modules 2 in the radial direction, preventing cracks from forming along the longitudinal seams, but does not address longitudinal expansion and contraction of the insulation layers as recited in Claim 1. Third, as illustrated in Figures 3 and 4 of Kikuchi, the contraction/expansion joints 5 extend lengthwise

along the modules, and not circumferentially around the longitudinal axis of the module as recited in Claim 1.

The contraction/expansion joints recited in Claim 1 are totally different in structure and function from the joints cited by the Examiner in Kikuchi. Structurally, applicant's joints extend radially and circumferentially around the module, whereas those in Kikuchi extend radially and lengthwise along the module. The structural difference is indicative of the difference in function between the joints; applicant's joints compensate for longitudinal expansion and contraction, whereas the joints in Kikuchi compensate for radial expansion and contraction.

One of the criteria necessary to establish a prima facie case of obviousness is that the references must teach or suggest all claim limitations. Applicant has demonstrated that Kikuchi fails to meet this criterion because the cited reference does not teach a contraction/expansion joint comprising a recess extending circumferentially around an insulation module and providing for longitudinal expansion and contraction of the module as recited in Claim 1. As such, Kikuchi cannot properly support rejection of Claim 1 on the basis of obviousness.

With respect to the combination of Kikuchi and Tonokawa, applicant respectfully asserts that there is no motivation for this proposed combination. Claim 1 recites that the first inner insulation layer of the insulation module is formed of a flexible insulation material. In contrast, Kikuchi teaches the use of rigid foams for the insulation module disclosed therein. (See column 4, lines 65-69). Kikuchi clearly teaches away from using the flexible insulating foam as taught in Tonokawa, and where there is a teaching away, there can be no motivation to combine references. Applicant asserts,

respectfully, that the Examiner is using impermissible hindsight based upon the applicant's own teachings to combine two references which teach away from one another and are, therefore, not properly combinable to arrive at a combination which yields applicant's invention. It must be remembered that another criteria required to establish a prima facie case of obviousness is that there must be some motivation to combine the reference teachings. Once again, however, the proposed references fail to meet the minimum necessary requirements to establish the prima facie case of obviousness. Applicant contends that the proposed references are not properly combinable and that they do not support a rejection of Claim 1 on the basis of obviousness.

Claims 2-4, 14-17, 19, 20, 24-26 and 31 depend, either directly or indirectly, upon Claim 1 and should be allowable over the cited references for the same reasons that Claim 1 is allowable.

Claim 30

Claim 30 is an independent claim which recites substantially the same features as recited in Claim 1. As such, it should be allowable over the cited references for the same reasons that Claim 1 is allowable; that is, the combination of Kikuchi and Tonokawa teach away from one another and are, therefore, not properly combinable because there is no motivation to combine references which teach away from one another.

Summary

Applicant has demonstrated in the arguments presented above that the pending claims are allowable over the cited references because these references fail to meet the criteria required to establish a prima facie case of obviousness in that they do not teach or suggest all of the claim limitations

and are not properly combinable due to a lack of motivation. Applicant respectfully contends that the application as amended is in condition for allowance and requests that it be passed to issue.

Respectfully submitted,

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Enclosures

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